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Paper 26

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OFFICE OF PETITIONS
ON PETITION

In re Application of
Van Der Ploeg, et al.
Application No. 08/554,424
Filed: 6 November, 1995
Attorney Docket No.: 19338CDCPA2

This is a decision on the petitions filed on 1 November, 2001, respectively and alternatively, under 37 C.F.R. §1.181¹ seeking the withdrawal of the holding of abandonment and 37 C.F.R. §1.137(b)² to revive an application abandoned due to unintentional delay.

¹ The regulations at 37 C.F.R. §1.181 provide, in pertinent part:

§1.181 Petition to the Commissioner.

(a) Petition may be taken to the Commissioner: (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court; (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. * * *

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Brief or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declaration (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, it may be required that there have been a proper request for reconsideration (§1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his decision upon the matters averred in the petition, supplying a copy thereof to the petitioner.

(d) Where a fee is required for a petition to the Commissioner the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed. * * *

(f) Except as otherwise provided in these rules, any such petition not filed within 2 months from the action complained of, may be dismissed as untimely. The mere filing of a petition will not stay the period for reply to an Examiner's action which may be running against an application, nor act as a stay of other proceedings. * * *

² The regulations at 37 C.F.R. §1.137 provide in pertinent part:

§ 1.137 Revival of abandoned application, terminated reexamination proceeding, or lapsed patent.

(b) *Unintentional.* If the delay in reply by applicant or patent owner was unintentional, a petition may be filed pursuant to this paragraph to revive an abandoned application, a reexamination proceeding terminated under §§ 1.550(d) or 1.957(b) or (c), or a lapsed patent. A grantable petition pursuant to this paragraph must be accompanied by:

(1) The reply required to the outstanding Office action or notice, unless previously filed;

(2) The petition fee as set forth in § 1.17(m);

(3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Commissioner may require additional information where there is a question whether the delay was unintentional; and

(4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

(c) *Reply.* In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must include payment of the issue fee or any outstanding balance. In an application, abandoned for failure to pay the publication fee, the required reply must include payment of the publication fee.

* * *

[47 Fed. Reg. 41277, Sept. 17, 1982, effective Oct. 1, 1982; para. (b) 48 Fed. Reg. 2713, Jan. 20, 1983, effective Feb. 27, 1983; paras. (a) - (c), paras. (d) & (e) added, 58 Fed. Reg. 44277, Aug. 20, 1993, effective Sept. 20, 1993; para. (c) revised, 60 Fed. Reg. 20195, Apr. 25, 1995, effective June 8, 1995; revised, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (c) revised, 65 Fed. Reg. 54604, Sept. 8, 2000, effective Sept. 8, 2000; revised, 65 Fed. Reg. 57024, Sept. 20, 2000, effective Nov. 29, 2000]

The petition under 37 C.F.R. §1.181 is **DISMISSED** for reasons as set forth below,³ and the petition under 37 C.F.R. §1.137(b) is **GRANTED**.

BACKGROUND

A review of the record reveals:

- in response to a Continued Prosecution Application filed on 14 April, 2000 (the April 2000 CPA), the Office mailed A the Notice of Missing Parts on 25 April, 2000 (the April Notice), requiring that Petitioner pay the basic filing fee of \$690.00 and the \$130.00 surcharge for delayed payment of the basic filing fee and file this response within two months of the Notice, however, the April 2000 Notice was mailed to Petitioner's former address (at Anderson Ct. in Orlando, FL);
- the office remailed the April Notice on 26 July, 2000 (the July Notice), this time to Petitioner's new address (at Hillcrest St. in Orlando, FL);
- when Petitioner failed to reply timely and properly to the July Notice, the Office mailed a Notice of Abandonment on 27 February, 2001, to Petitioner's Hillcrest St. address;
- on 1 November, 2000, Petitioner filed the instant petition with:
 - credit card authorization sufficient for the petition fee, basic filing fee and delayed-payment surcharge;
 - Petitioner's chronology of events and characterization thereof;
 - a Terminal Disclaimer and credit card authorization for the fee.

In short, Petitioner contends he was confused:

- although the coversheet of the July Notice contained the Hillcrest St. address, the attached April Notice contained the Anderson Ct. address;
- as a result, Petitioner alleges that it was his belief that the April and July 2000 Notices were erroneously mailed by the Office in response to an earlier CPA filed in October 1999--and not the April 2000 CPA;
- moreover, while Petitioner changed his docket number when he filed the April 2000 CPA from "19338DA" to "19338CDCPA2," the April and July Notices referenced a the old docket number.

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is

³ Pursuant to Petitioner's authorization, the petition fee of \$1,280.00, the basic filing fee of \$740.00 (The fee was \$690.00 when the Notices were mailed, however, during the period in which Petitioner delayed the fee schedule changed) and the delayed-payment surcharge of \$130.00 are charged to the credit card account listed.

shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).⁴ And the regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably⁵ or unintentionally, respectively, abandoned application under this congressional grant of authority. Further, Petitioner must evidence at least such diligence in addressing a question of abandonment as one must evidence in the prosecution of the application--i.e., such diligence as one would give to one's most important business affairs.⁶

Moreover, the courts have determined the construct for properly supporting an allegation of non-receipt of an Office action in seeking withdrawal of a holding of abandonment.⁷

Petitioner's Argument of Confusion

The April 2000 Notice--the one Petitioner claims confused him because, *inter alia*, it contained an old address and docket number, states in the first paragraph:

The Continued Prosecution Application (CPA) request filed on APRIL 14, 2000, is entitled to a filing date under 37 C.F.R. §1.53(d)(1). The CPA request, however, lacks the filing fees(s) and/or items indicated below. (Emphasis supplied.)

There is no question that the Notice addresses the April 2000, and not the October 1999, CPA--unless, of course, one fails to read the Notice.

Attached to the July Notice was a copy of the April Notice and a one-page form that:

- informed Petitioner the two- (2-) month response time was restarted;
- states expressly: "Remailed Office action . . . which was mailed to the wrong address"; and

⁴ 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

⁵ The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition. Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional. Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

⁶ Ex parte Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (Comm'r Pat. 1887). See also: In re Mattullath, 38 App. D.C. 497, 514-15 (D.C. Cir. 1912); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913). Decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). A petition cannot be granted where a petitioner has failed to meet his or her burden of proof. Haines v. Ouigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987).

⁷ See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).

- set forth the name and the telephone number of the person at the Office who could answer Petitioner's questions regarding the mailing.

Thus, without reading the text of the Notices mailed to him in July 2000 Petitioner let the reply deadline pass without any response or inquiry, yet Petitioner argues that the holding of abandonment should be withdrawn because he was confused.⁸

It is an interesting argument--but one which is wholly unpersuasive because it has no basis in law.

To the contrary, as noted earlier the statutory provisions at 35 U.S.C. §133 (1994) mandate abandonment in the absence of proper timely reply to an Office action or Notice, and the regulations at 37 C.F.R. §1.134⁹ and §1.135¹⁰ provide similar requirements and effects.

As is clear, Petitioner fails to satisfy the burdens set forth in Delgar v. Schulyer.

Withdrawal of the holding of abandonment is not proper.

Alternative Venue

Petitioner has satisfied the requirements for revival under 37 C.F.R. under 37 C.F.R. §1.137(b).¹¹

Therefore, for the reasons stated above the petition under 37 C.F.R. §1.181 is **dismissed**, and the petition under 37 C.F.R. §1.137(b) is **granted**.

This application is being forwarded to Technology Center 1600 for further processing.

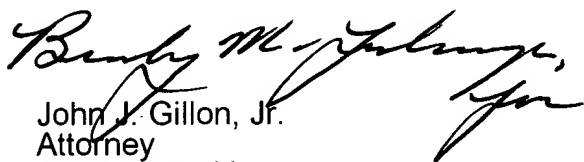
⁸ As for Petitioner's change of docket number from "19338DA" to "19338CDCPA2," it is unfortunate that the Office did not pick up this change made by Petitioner, however, it is notable that in filing his Rule 53(d) CPA--which retains the same file number, wrapper and prosecution history--Petitioner failed to note for the Office that he was making this change. In fact, Petitioner did not file a Notice of Change of Address when he moved, but rather included that change only in the Transmittal Sheet for the April 2000 CPA Request.

⁹ The regulations at 37 C.F.R. §1.134 provide:
§ 1.134 Time period for reply to an Office action.
An Office action will notify the applicant of any non-statutory or shortened statutory time period set for reply to an Office action. Unless the applicant is notified in writing that a reply is required in less than six months, a maximum period of six months is allowed.
[47 Fed. Reg. 41276, Sept. 17, 1982, effective Oct. 1, 1982; revised, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997]

¹⁰ The regulations at 37 C.F.R. §1.135 provide:
§ 1.135 Abandonment for failure to reply within time period.
(a) If an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise.
(b) Prosecution of an application to save it from abandonment pursuant to paragraph (a) of this section must include such complete and proper reply as the condition of the application may require. The admission of, or refusal to admit, any amendment after final rejection or any amendment not responsive to the last action, or any related proceedings, will not operate to save the application from abandonment.
(c) When reply by the applicant is a *bona fide* attempt to advance the application to final action, and is substantially a complete reply to the non-final Office action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, applicant may be given a new time period for reply under § 1.134 to supply the omission.
[Paras. (a), (b), and (c), 47 Fed. Reg. 41276, Sept. 17, 1982, effective Oct. 1, 1982; para. (d) deleted, 49 Fed. Reg. 555, Jan. 4, 1984, effective Apr. 1, 1984; revised, 62 Fed. Reg. 53131, Oct. 10, 1997, effective Dec. 1, 1997]

¹¹ See: Fn. 2.

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